

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-9, 11, 13-18, 19-23 and 25 are rejected under 35 USC 102(b) over the U.S. patent Modrey (2,776,385).

Also, claims 20 and 22 have been rejected under 35 USC 112.

With the present Amendment applicants cancelled claims 20 and 22 and submitted new claims 26-35.

The feature of claim 26 is disclosed in the specification on page 6, lines 11-15 and in Figures 4 and 6.

The feature of claim 27 is disclosed in Figure 4 and is also disclosed on page 6, line 13 of the specification.

The feature of claim 28 is disclosed in Figures 4-7.

The features of claims 29 and 30 are disclosed in the specification on page 6, lines 11-15 and in Figures 4 and 6.

The feature of claim 31 is disclosed in Figure 4.

The features of claims 32 and 33 are disclosed in Figures 4 and 6.

The feature of claim 34 is disclosed on page 4, line 12.

In claim 35, the term “longitudinal direction” is replaced with the term “axial direction”.

It is respectfully submitted that the new features of the present invention as defined in claim 1 are not disclosed in the references and cannot be derived from them as a matter of obviousness.

The patent to Modrey discloses an electric power unit including an electric motor which is enclosed in a housing (13). Furthermore, the electric power unit includes a cooling device for cooling the motor, an inlet opening for cooling air is built in a plug (25). The cooling air flows through a hose (16) to the motor and then back in the plug, which includes also an outlet opening for cooling air. Furthermore, the housing (13) has an internal structure which forms cooling conduits and a motor housing in one piece. A junction (32) which fixes the hose (16) to the outer wall of the housing (13) builds an intake nozzle which is placed in the outer wall of the housing (13).

The patent to Modrey lacks the feature that the intake nozzle built by the junction (32) extends in a longitudinal direction of the housing (13).

It should be emphasized that the longitudinal direction of the housing (13) in the patent to Modrey corresponds to the direction extending along the longest edge of the housing (13), according to the very definition of the word "longitudinal."

However, the direction which is interpreted as the longitudinal direction of the housing (13) in the patent to Modrey is arranged diagonally in respect to the longest edge of the housing (13) as can be seen in the explanatory figure in the Office Action. The direction shown by the Examiner in the explanatory figure is the longitudinal direction of the intake nozzle but not the longitudinal direction of the housing (13).

The original claims were rejected over the patent to Modrey as being anticipated. In view of the above presented remarks and amendments, it is believed to be clear that the new features of the present invention as defined in claim 1 are not disclosed in the Modrey reference. In connection with this, it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Modrey does not disclose each and every element of the electric power tool defined in claim 1 and therefore the anticipation rejection should be considered as not tenable with respect to claim 1 and should be withdrawn.

The present invention as defined in claim 1 also cannot be considered as obvious from this reference.

In the patent to Modrey, the junction of the hose (16) to the housing (13) builds the intake nozzle, which is arranged diagonally with respect to the longitudinal direction of the housing (13). Due to the diagonal extension of the intake nozzle, a deflection of the air flow on the way from the intake nozzle (20) to the motor is necessary and the cooling effect can therefore be affected.

Claim 1 currently on file defines an electric power tool with a cooling device (16, 18, 20, 30, 32), wherein the cooling device (16, 18, 20, 30, 32) comprises at least one intake nozzle (20) extending in a longitudinal direction (42) of the housing (10). Due to this, the air flow can reach the motor without deflection and the cooling effect can be increased.

In the reference there is no motivation for a person skilled in the art willing to increase the cooling effect of the cooling device taught by Modrey to place the intake nozzle such that it extends in the longitudinal direction of the housing (13).

The patent to Modrey teaches to place air inlet openings in the outer wall of a plug (25) such that they cannot be covered by a user's hand (see the patent to Modrey, column 3, lines 8 to 12). Furthermore, the junction (32) which builds the intake nozzle is placed in the region of a corner of the housing (13), such that the hose (16) does not affect the handiness of the power tool.

Therefore, it is definitely not obvious that a person skilled in the art would have placed the junction (32) on the upper wall of the housing (13) such that the intake nozzle extends in the longitudinal direction of the housing (13), because the hose (16) would render the use of the power tool more difficult, since it would be placed in the region of the handle. The person skilled in the art would also not be motivated to place an air inlet opening in this upper wall of the housing (13) such that an intake nozzle extends in the longitudinal direction of the housing (13), since it would be placed in the region of the handle and could therefore be covered by a user's hand.

Since the person skilled in the art could not find at the time the invention was made any motivation in Modrey to modify the power tool taught therein in the way defined in claim 1, the present invention according to claim 1 can not be considered as obvious from the patent to Modrey and is inventive over the solution proposed in the patent Modrey.

Turning now to claims 32 and 33 it is respectfully submitted that the internal structure of the housing (13) in the patent to Modrey, which the Examiner considers as additional casing, is integrally formed with the housing (13). That means that the housing (13) and the “additional casing” are constructed as one piece, as shown in Figure 1 in the patent to Modrey.

In contrast, the cooling device (16, 18, 20, 30, 32) defined in claim 1 comprises a cooling conduit (30) which is separated from the housing (10) in a direction which is transverse to said longitudinal direction (42) of the housing (10) and by an additional casing (38) which is, according to claim 32, manufactured separately from the housing (10) and, according to claim 33, separated from the housing (10).

Due to the fact that the patent to Modrey discloses no additional casing which is separated from the housing (13) (claim 33) and manufactured

separately from the housing (13) (claim 32), the electric power tool defined in claims 32 and 33 is new over the patent to Modrey.

It is therefore believed to be clear that the anticipation rejection should be considered as not applicable with respect to claims 32 and 33 as well.

The features of claim 32 and 33 also cannot be considered as obvious from the teaching of the patent to Modrey.

Due to the arrangement as defined in claims 32 and 33, the cooling conduit (30) is separated from the housing (10) by means of the additional casing (38) so that the cooling conduit (30) can be practically removed from the housing (10) for instance for the purpose of cleaning or repairing. In addition, the housing of an electric power tool can be manufactured and produced easily and economically in a modular construction.

A person skilled in the art could not find in Modrey any hints which would have motivated him to build the cooling conduit by means of an additional casing being separated from the housing (13) or being manufactured separately from the housing (13), since Modrey teaches to build a cooling conduit integrally with the housing (13).

It is therefore respectfully submitted that claims 32 and 33 should also be considered as not obvious from the patent to Modrey and patentably distinguishing over it, and should also be allowed.

As for the other dependent claims, these claims depend on claim 1, they share its presumably allowable features and they should be allowed as well.

Reconsideration and allowance of the present application with all the claims currently on file is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicant
Reg. No. 27233